

S/N 10/611,843

Atty Dkt No. GP-302711 (GM-0330PUS)

REMARKS

Claims 1-28 are pending in this application. Claims 1-18 and 20-28 are rejected under 35 U.S.C. § 112, first paragraph, and claims 1, 8 and 16 are rejected under 35 U.S.C. § 102(b). Claim 19 is allowed.

Applicants responded to the September 27, 2004 Final Office Action with a Reply on November 22, 2004. The Reply included three separate Declarations under 37 C.F.R. § 1.132 addressing the Section 112, first paragraph rejections. Applicants also argued that the Section 102(b) rejections were improper. In an Advisory Action mailed December 21, 2004, the Examiner indicated that the Declarations would not be considered as they were not directed solely to issues which were newly raised by the Examiner in the final rejection. Also, the Examiner indicated that the request for reconsideration (i.e., the November 22, 2004 Reply) was considered, but does not place the Application in condition for allowance. Accordingly, Applicants have filed a Request for Continued Examination, including the requisite submission and fee under 37 C.F.R. § 1.114(c) concurrent with this Amendment. The present Amendment constitutes a submission under 37 C.F.R. § 1.114(c) with respect to the Section 102(b) rejections. Additionally, the Declarations constitute a submission under 37 C.F.R. § 1.114(c) with respect to the Section 112, first paragraph rejections. Applicants have included another copy of these previously filed but not considered Declarations with this Amendment for the convenience of the Examiner.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-18 and claims 20-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that:

The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and/or use the invention. The specification does not disclose how the inner member can be made in one-piece and the outer member can be made in one-piece. It is unclear how each of these members could be constructed according to the techniques disclosed by the applicant, as they are far more complex than any frame member made in one-piece according to the prior art. It is unclear how the members could be constructed without welding or joining in some manner smaller pieces to construct the inner or outer member.

Because the Declarations provided with the November 22, 2004 Reply were not considered in the Advisory Action, Applicants' arguments included in that Reply relating to the Section 112 rejections and the Declarations are repeated as follows for consideration pursuant to the Request for Continued Examination. The CAFC has indicated that the test of enablement is whether one reasonably skilled in the art could make or use the inventions from the disclosures in the patent contemplated with the information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). See also MPEP 2164.01.

The Examiner disputes "that it is well know to use [the techniques of quick plastic forming, super plastic forming and hydroforming] to make a one-piece vehicle frame member of the size and shape depicted by applicant." The Examiner advises, "If the process is readily apparent to one of ordinary skill in the art and no prior art reference can be found, then some explanation should be given as to why all prior art frames of similar size and complexity are made of multiple sections joined together rather than in one-piece as applicant suggests."

Accordingly, Applicants have attached Declarations of engineers representing persons of ordinary skill in the arts of vehicle body and frame design and manufacture indicating that they would readily understand how to apply the methods discussed in the Application and/or incorporated therein by reference to make one-piece

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inner member and the one-piece outer member described. The attached Declarations under 37 C.F.R. § 1.132 of Richard Murray Kleber, Paul E. Krajewski and James G. Schroth are hereby incorporated by reference in their entirety. Additionally, per the Examiner's request, an explanation is provided as to why Applicants' one-piece inner and outer members may be larger than other prior art products formed using similar methods.

Claim 28 has been amended to clarify that the "providing a body and frame assembly" step means providing a body and frame assembly that includes the inner member and the outer member mounted to one another pursuant to the mounting step of amended claim 20.

Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1, 8 and 16 under 35 U.S.C. § 102(b) as being anticipated by Schroeder et al., United States Patent No. 6,206,458. According to the Examiner, Schroeder et al. disclose:

a body and frame assembly for a vehicle comprising a one-piece inner member (16) mated with a one-piece outer member (12), each of the members defining door openings for opposing sides of the vehicle (the door openings of the inner member oppose the door openings of the outer member).

As may be seen in Figure 2 of Schroeder et al., the one-piece outer member 12 defines door openings for only the left side of a vehicle and the one-piece inner member 16 defines door openings for only the right side of the vehicle. The Examiner acknowledges this by stating with respect to Schroeder et al. that "the door openings of the inner member oppose the door openings for the outer member." In order to further clarify the distinction between Applicants' one-piece inner member and one-piece outer member and those disclosed by Schroeder et al., claim 1 is amended to specify that the "inner member defin[es] door openings at opposing sides of the vehicle and [the] outer member further defin[es] [the] door openings at [the] opposing sides of the vehicle." Accordingly, it is clear that under claim 1 and claims 8 and 16 which ultimately depend

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from claim 1, *each* one of the inner and the outer member defines door openings at opposing sides (plural) of the vehicle. Thus each one defines door openings at the left side and at the right side. As may be viewed in Figure 1a, and as described in paragraph [0015] of the Application, the outer member 10 forms door openings 22A and 23A extending from the outer roof panel portion first end 14 and door openings 22B and 23B extending from the opposing outer roof panel portion second end 16 (i.e., on opposite sides of a vehicle as shown in Figure 2a). Similarly, as illustrated in Figure 1b and described in paragraph [0022], the inner member 42 forms door openings 69A and 70A extending from the inner roof panel portion first end 46 and door opening 69B and 70B extending from the opposing inner roof panel portion second end 48 (i.e., on opposite sides of the vehicle as shown Figure 2a).

As stated above, Schroeder et al.'s inner member 16 and outer member 12 each only defines door openings at one side of the vehicle (not "at opposing sides," as required by claim 1) and Schroeder et al.'s outer member 12 only defines door openings at one side of the vehicle (the side opposing that at which the inner member 16 defines door openings). Only together do Schroeder et al.'s inner member 16 and outer member 12 define door openings for opposing sides of the vehicle.

For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Thus, because Schroeder et al. do not provide an inner member and an outer member each of which "defines door openings at opposing sides of the vehicle", Schroeder et al. do not anticipate claim 1, nor claims 8 and 16 which depend therefrom.

Conclusion

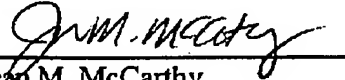
In light of the above remarks, the amendments and the affidavits, it is believed that all claims are in condition for allowance, which action is respectfully requested.

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Respectfully submitted,

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